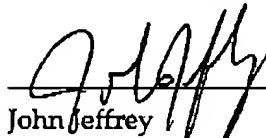


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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: John Peterson

For: HOME AUTOMATION AND SECURITY SYSTEM CONTROLLER

Serial No.: 09/403,593

Filed: February 15, 2000

Art Unit: 3628

Our Reference: JJ-9722US

133 Richmond St. West, Suite 301
TORONTO, Ontario M5H 2L7

August 19, 2004

Commissioner of Patents & Trademarks
Washington, D.C. 20231**APPEAL BRIEF**

The appellant hereby appeals from the final rejection of claims 1, 2 and 4 to 8. What follows is appellant's Appeal Brief as required by 37 CFR 1.192(a).

REAL PARTY OF INTEREST

The real party of interest in this appeal is the assignee, Digital Security Controls, Ltd.

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RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to this appeal.

STATUS OF CLAIMS

Claim 4 was objected to as being informal as it depended upon itself. A separate paper filed after final has amended claim 4 to overcome the objection.

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Humphries et al (US 5,621,662), Moderi et al (US 5,510,979) and Mahoney et al (US 5,819,271).

Claims 5 to 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Humphries et al (US 5,621,662) and Mahoney et al (US 5,819,271).

The appellant appeals from the final rejection of claims 1, 2 and 4 to 8.

STATUS OF AMENDMENTS

A response was filed on March 25, 2004 amending claim 4 to overcome the objection of the claim being dependent upon itself.

SUMMARY OF THE INVENTION

The present invention in one aspect is directed to controller for controlling the function of components of a security system. The controller includes a touch sensitive screen with a graphical representation of the security system and the components displayed on the screen (page 5, lines 1 to 9). The controller interacts with a control panel to control operation of the security system (page 4, lines 9 to 14), the function of the components of the security system being controllable by touching a portion of the screen having the component or security system to be controlled displayed thereon (page 5, lines 7 to 23). The controller also provides for selection and display of user selectable information not related to the operation of the security system and provided to the control panel by an external data access provider (page 6, line 31 to page 8, line 34). Preferably, the user selectable information is one or more items

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selected from the group consisting of weather information, news reports, sports information, and financial information (page 6, lines 31 to 35, page 7, lines 16 to 19).

In a preferred embodiment, the controller also provides for control of home automation functions by providing a display of the environment conditions capable of being controlled in the home automation functions (page 5, line 25 to page 6, line 13).

The present invention is also directed to a security system having a plurality of detection devices and a controller connected to a control panel (page 3, line 27 to page 4, line 14). The control panel has a means for connecting to an external data access provider for providing user selectable information not related to the operation of the security system (page 6, lines 31 to 37, Figure 1). The controller has an input means for inputting data in response to prompts, and a display means for displaying at least a number of alphanumeric characters (page 4, lines 16 to 36). The controller interacts with the control panel to control operation of the security system (page 4, lines 9 to 14) and display the user selectable information provided to the control panel by the external data access provider (page 6 31 to page 8, line 34).

Preferably, the controller also provides for control of home automation functions (page 5, line 25 to page 6, line 13) and the display means is a LCD or LED display capable of displaying graphical data (page 4, lines 22 to 34).

The present invention is also directed to a security systems as described above in which the user selectable information is one or more items selected from the group consisting of weather information, news reports, sports information, and financial information (page 6, lines 31 to 35, page 7, lines 16 to 19).

THE ISSUES

The issues presented for appeal herein are the rejections of claims 1, 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Humpries et al (US 5,621,662), Moderi et al (US 5,510,979) and Mahoney et al (US 5,819,271) and claims 5 to 8 under 35

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U.S.C. § 103(a) as being unpatentable over Humpries et al (US 5,621,662) and Mahoney et al (US 5,819,271).

GROUPING OF CLAIMS

Claims 1, 2 and 4 are directed to a controller for a security system and are to be considered individually. Claims 5 to 8 are directed to a security system and are also to be considered individually.

ARGUMENTS

THE 35 U.S.C. § 103(a) REJECTION OF CLAIMS 1, 2 AND 4

The Examiner's rationale for rejecting claims 1, 2 and 4 as being unpatentable over Humpries et al, Moderi et al and Mahoney et al was stated as follows in the final rejection:

"Re Claim 1: Humphries et al. disclose a controller(Abstract, (col. 2, lines 33-46) for controlling the function of components, the controller interacting with a control panel to control operation of the security system (Abstract, Col. 8, Lines 49-67, Col. 9, Lines 45-55, Col. 14, Lines 50-62, Col. 17, Lines 10-21, Col. 18, Lines 5-50, Col. 19, Lines 10-30, 35-45, Col. 20, Lines 5-15, 40-60, Col. 21, Lines 5-20, 40-50) the function of the components of the security system being controllable by touching a portion of the screen having the component or security system, the controller also providing for, selection and display of user selectable information not related to the operation of the security system(Col. 14, Lines 50-62, Col. 17, Lines 10-21, Col. 18, Lines 5-50, Col. 19, Lines 10-30, 35-45, Col. 20, Lines 5-15, 40-60, Col. 21, Lines 5-20, 40-50).

Humphries et al. does not explicitly disclose(s) a touch sensitive screen with a graphical representation of the security system and the components displayed on the screen, to be controlled displayed thereon. However, in col. 1, lines 36-43, col. 7, lines 1-15 thereof, Moderi et al. disclose(s) indicating a touch-sensitive screen connected to a microcomputer by a touch-sensitive screen interface and a video monitor connected to

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microcomputer. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Humphries et al. by adopting the teachings of Moderi et al. The motivation to combine these references is it enables easier product construction and use in the home environment.

Humphries et al. does not explicitly disclose(s) an external data access provider. However, in Abstract, Fig. 1, col. 1, line 60-col. 2, line 55 thereof, Mahoney et al. disclose(s) Bloomberg-Multex Research that an external data provider providing access to corporate data news reports on a daily basis. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Humphries et al. by adopting the teachings of Mahoney et al. The motivation to combine these references is to ensure access to weather information, news reports, sports information, and financial information from a connection leading into the home environment. The Fig. 1 shows the connection from the external data access provider to the PC inside of the home. It would be obvious that if corporate news and financial reports are transmitted into the home computer that the same reports along with weather and sports reports are also transmittable into the home via any other computerized device.

Re Claim 2: Humphries et al. disclose a controller(Col. 2, lines 33-46) that provides for control of home automation functions by providing a display of the environment conditions capable of being controlled in the home automation functions(Col. 4, lines 42-67).

Re claim 4: Humphries et al. does not explicitly disclose(s) user-selectable information that consists of one or more items selected from the group consisting of weather information, news reports, sports information, and financial information. However, in Abstract, Fig. 1, 3, col. 1, line 60-col. 2, line 55, Col. 10, Lines 7-40, Col. 11, Lines 40-53, thereof, Mahoney et al. disclose(s) Bloomberg-Multex Research that an external data provider providing access to corporate data news reports on a daily basis. Thus, it would have been obvious to one of ordinary skill in the art to modify the

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method of Humphries et al. by adopting the teachings of Mahoney et al. The motivation to combine these references is to ensure access to weather information, news reports, sports information, and financial information from a connection leading into the home environment. It would be obvious that if corporate news and financial reports are transmitted into the home computer that the same reports along with weather and sports reports are also transmittable into the home via any other computerized device."

Humphries et al describe a home automation system for controlling various aspects of a house. While Humphries describes a controller for controlling, in part, the operation of a security system, Humphries' controller does not provide for a touch sensitive screen, nor is one able to touch a portion of the screen having the component of the security system thereon. In addition, there is no teaching or suggestion of providing for selection and display of user selectable information not related to the operation of the security system provided by an external data access provider.

Moderi describes a point of sale register system for entering and tabulating customer orders where the point of sale registers are provided with a touch screen having a plurality of keys, each being associated with a label of a saleable item or category of saleable items. This point of sale system is also provided with an access control system whereby users of the system have to sign in utilizing a swipe card and/or password entry system. There is no teaching however, of utilizing the touch sensitive screen of Moderi in a security system, nor is there any teaching which would have led one of skill in the art to substitute the controller of Humphries with the touch sensitive point of sale register of Moderi. Also, once again, there is no teaching or suggestion of providing for selection and display of user selectable information not related to the operation of a security system provided by an external data access provider.

Mahoney et al describes a corporation information delivery system having databases storing research reports related to the operation of the corporation produced

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by and received electronically from brokerage firms. A user may connect to the databases through a webserver accessible via the internet. As the user has access to the internet, the user would also have access to other types of information, such as news reports, press releases, weather reports, sports and news. However, as set out in Mahoney et al, in column 6, beginning on line 24, each user has a user computer, such as a personal computer with an Intel Pentium processor and a fast modem that the user can use to connect to the internet. This is described also in column 11, beginning in line 41. It is respectfully submitted that the teaching of Mahoney et al would not lead one of skill in the art to provide for a capability of a controller for a home security system to access an external data access provider to allow the controller to display information not related to the operation of the security system selected by the user of the security system. There is no teaching in the combination of Humphries et al, Moderi et al and Mahoney et al which would lead one of skill in the art to this controller.

The Examiner correctly states that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art when he states on page 2 of the Final Action:

"In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, while Humphries et al.'s screen is not touch-sensitive and Moderi et al.'s does, Examiners are permitted to combine references where it is obvious that the technologies can be combined incorporated herein. The Moderi et al. touch screen provides for user-selected information and it is obvious to combine the Moderi et al. touch screen with the

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Humphries et al. controller because the controller does permit connections to and access to outside information (Humphries et al., Abstract, Col. 8, Lines 45-60, Col. 9, Lines 45-56) and it is obvious this would include an outside data access provider."

However, it is respectfully submitted that in this case, the Examiner has incorrectly combined the teachings of the prior art, as there is no teaching, suggestion or motivation to do so in the cited art and it is respectfully submitted that one of skill in the art would not have been led to combine the references in the manner suggested by the Examiner, as it would not have been obvious to such a person to combine the technologies to arrive at the present invention. As set out by the Court of Appeals Federal Circuit *In re Fine*, cited by the Examiner, 5 USPQ2d, 1596, at 1599.

"Obviousness is determined by "what the combined teachings of the references would have suggested to those of ordinary skill in the art". *In re Keller*, 208 USPQ 871, 881. Obviousness "cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination" and "teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 933.

"To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312 (Fed. Cir. 1983).

"In order to establish obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the

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form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention." *Ex parte Levengood*, 28 USPQ2d 1300, 1301.

"The question is not whether a patentable distinction is created by viewing a prior art apparatus from one direction and a claimed apparatus from another, but, rather, whether it would have been obvious from a fair reading of the prior art reference as a whole to turn the prior art apparatus upside down. French teaches a liquid strainer which relies, at least in part, upon the assistance of gravity to separate undesired dirt and water from gasoline and other light oils. Therefore, it is not seen that French would have provided any motivation to one of ordinary skill in the art to employ the French apparatus in an upside down orientation. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 USPQ 1125, 1127.

"In this case, however, the only suggestion for the examiner's combination of the isolated teachings of the applied references improperly stems from appellant's disclosure and not from the prior art. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979). At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at the appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. See *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd.App. 1980). See also footnote 16 of *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). That one can *reconstruct* and/or

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explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 USPQ2d 1300, 1301.

It is respectfully submitted that in this situation, while the individual features of the present invention may have been known, there is no teaching in the prior art such that at the date of the invention, one of skill in the art would have been led to combine these features to arrive at the invention as described and claimed in the present application. There is no teaching in the prior art which would have provided the motivation to one of skill in the art to provide a controller for a security system with the capability of selecting and displaying user selectable information not related to the operation of the security system and provided by an external data access provider. As has been previously recognized by the Examiner, the provision of this information makes the controller of the present invention a multi-functional device enhancing its usefulness. However, there is no teaching or suggestion in the prior art which would have led one of ordinary skill in the art to provide such a feature to a security system controller. The statement by the Examiner that the motivation to combine the references is to ensure access to weather information, news reports, sports information, and financial information from a connection leading into the home environment may apply to a home computer but does not suggest that one of skill in the art would provide such capability to a security system controller. The Examiner has provided no support for the statement nor has the Examiner shown how the prior art provides such motivation. In fact, it is applicant's position that such motivation can not be found in the prior art.

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The mere statement by the Examiner that it would have been obvious to one of ordinary skill in the art to provide this feature, does not satisfy the requirements as set by the Court that one should not use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to arrive at the claimed invention, absent the teaching or suggestion supporting the combination. It is respectfully submitted that in the present circumstance, the Examiner has not provided any support or explanation for the combination as suggested. In fact, it is respectfully submitted that such teaching or suggestion of combining the references in the manner described by the Examiner, cannot be found.

THE U.S.C. § 103(a) REJECTION OF CLAIMS 5 to 8

The Examiner's rationale for rejecting claims 5 to 8 under 35 U.S.C. § 103(a) as being unpatentable over Humpries et al and Mahoney et al was stated as follows in the final rejection:

"Re claim 5: Humpries et al. disclose a security system comprising a plurality of detection devices and a controller connected to a control panel(Col. 2, Lines 3346, Col. 4, Lines 40-67, Col. 5, Lines 10-27, Col. 17, Lines 55-65, Col. 18, Lines 5-50, Col. 20, Lines 5-15, 40-60, Col. 21, Lines 5-20, 40-50), the control panel having a means for connecting (Col. 8, Lines 49-67, Col. 9, Lines 45-55), the controller having an input means for inputting data that responds to prompts, and a display means for displaying at least a number of alphanumeric characters(Col. 14, Lines 50-62, Col. 17, Lines 10-21, Col. 18, Lines 5-50, Col. 19, Lines 10-30, 35-45, Col. 20, Lines 5-15, 4060, Col. 21, Lines 5-20, 40-50), the controller interacting with the control panel to control operation of the security system and display the user selectable information(Col. 8, Lines 49-67, Col. 9, Lines 45-55, Col. 14, Lines 50-62, Col. 17, Lines 10-21, Col. 18, Lines 5-50, Col. 19, Lines 10-30, 35-45, Col. 20, Lines 5-15, 4060, Col. 21, Lines 5-20, 40-50).

Humpries et al. does not explicitly disclose(s) an external data access provider. However, in Abstract, Fig. 1, col. 1, line 60-col. 2, line 55 thereof, Mahoney et al. disclose(s) Bloomberg-Multex Research that an external

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data provider providing access to corporate data news reports on a daily basis. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Humphries et al. by adopting the teachings of Mahoney et al. The motivation to combine these references is to ensure access to weather information, news reports, sports information, and financial information from a connection leading into the home environment. The Fig. 1 shows the connection from the external data access provider to the PC inside of the home. It would be obvious that if corporate news and financial reports are transmitted into the home computer that the same reports along with weather and sports reports are also transmittable into the home via any other computerized device.

Re claim 6: Humphries et al. does not explicitly disclose(s) wherein the user selectable information is one or more items selected from the group consisting of weather information, news reports, sports information, and financial information. However, in Abstract, Abstract, Fig. 1, 3, col. 1, line 60-col. 2, line 55, Col. 10, Lines 740, Col. 11, Lines 40-53 thereof, Mahoney et al. disclose(s) Bloomberg-Multex Research that an external data provider providing access to corporate data news reports on a daily basis. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Humphries et al. by adopting the teachings of Mahoney et al. The motivation to combine these references is to ensure access to weather information, news reports, sports information, and financial information from a connection leading into the home environment. It would be obvious that if corporate news and financial reports are transmitted into the home computer that the same reports along with weather and sports reports are also transmittable into the home via any other computerized device.

Re claim 7: Humphries et al. disclose the controller also provides for control of home automation functions(Col. 3, Lines 50-67, Col. 4, Lines 1-67).

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Re claim 8: Humphries et al. disclose the display means is a LCD or LED display capable of displaying graphical data(Col. 14, Lines 50-62, Col. 17, Lines 10-21, Col18, Lines 5-50, Col. 19, Lines 10-30, 35-45, Col. 20, Lines 5-15, 40-60, Col. 21, Lines 5-20, 40-50, Fig. 15).."

As set out above, Humphries et al describe a home automation system for controlling various aspects of a house. While Humphries describes a security system as part of the home automation system, Humphries' does not provide for a touch sensitive screen, nor is there is any teaching or suggestion of providing for selection and display of user selectable information not related to the operation of the security system provided by an external data access provider.

Mahoney et al describes a corporation information delivery system having databases storing research reports related to the operation of the corporation produced by and received electronically from brokerage firms. A user may connect to the databases through a webserver accessible via the internet. As the user has access to the internet, the user would also have access to other types of information, such as news reports, press releases, weather reports, sports and news. However, the teaching of Mahoney et al would not lead one of skill in the art to provide for a capability of a controller for a home security system to access an external data access provider to allow the controller to display information not related to the operation of the security system selected by the user of the security system.

Similar to the situation with claims 1, 2 and 4, it is respectfully submitted that in this situation, while the individual features of the present invention may have been known, there is no teaching in the prior art such that at the date of the invention, one of skill in the art would have been led to combine these features to arrive at the invention as described and claimed in claims 5 to 8. There is no teaching in the prior art which would have led one of skill in the art to provide a controller for a security system with the capability of selecting and displaying user selectable information not related to the operation of the security system and provided by an external data access provider. Once again, the statement by the Examiner that the motivation to combine the

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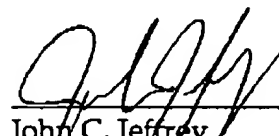
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references is to ensure access to weather information, news reports, sports information, and financial information from a connection leading into the home environment may apply to a home computer but does not suggest that one of skill in the art would provide such capability to a security system controller. The Examiner has provided no support for the statement nor has the Examiner shown how the prior art provides such motivation. In fact, it is applicant's position that such motivation can not be found in the prior art.

The mere statement by the Examiner that if corporate news and financial reports are transmitted into a home computer that the same reports along with weather and sports reports are also transmittable into the home via any other computerized device, does not satisfy the requirements as set by the Court that one should not use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to arrive at the claimed invention, absent the teaching or suggestion supporting the combination. It is respectfully submitted that in the present circumstance, the Examiner has not provided any support or explanation for the motivation or impetus to one of skill in the art to make the combination as suggested. In fact, it is respectfully submitted that such teaching or suggestion of the motivation or impetus to combine the references in the manner described by the Examiner, cannot be found.

Accordingly, in view of all of the above, it is respectfully submitted that the claims of the application define a patentable invention over the prior art.

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APPENDIX

1. A controller for controlling the function of components of a security system comprising a touch sensitive screen with a graphical representation of the security system and the components displayed on the screen, the controller interacting with a control panel to control operation of the security system, the function of the components of the security system being controllable by touching a portion of the screen having the component or security system to be controlled displayed thereon, the controller also providing for, selection and display of user selectable information not related to the operation of the security system and provided to the control panel by an external data access provider.
2. A controller as claimed in claim 1 wherein the controller also provides for control of home automation functions by providing a display of the environment conditions capable of being controlled in the home automation functions.
4. A controller as claimed in claim 1 wherein the user selectable information is one or more items selected from the group consisting of weather information, news reports, sports information, and financial information.
5. A security system comprising a plurality of detection devices and a controller connected to a control panel, the control panel having a means for connecting to an external data access provider for providing user selectable information not related to the operation of the security system, the controller having an input means for inputting data in response to prompts, and a display means for

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displaying at least a number of alphanumeric characters, the controller interacting with the control panel to control operation of the security system and display the user selectable information provided to the control panel by the external data access provider.

6. A security system as claimed in claim 5 wherein the user selectable information is one or more items selected from the group consisting of weather information, news reports, sports information, and financial information.

7. A security system as claimed in claim 6 wherein the controller also provides for control of home automation functions.

8. A security system as claimed in claim 7 wherein the display means is a LCD or LED display capable of displaying graphical data.